No. 15-866

In The

Supreme Court of the United States

STAR ATHLETICA, L.L.C.,

Petitioner,

v.

VARSITY BRANDS, INC., et al.,

Respondents.

On Writ Of Certiorari To The United States Court Of Appeals For The Sixth Circuit

BRIEF AMICUS CURIAE ON BEHALF OF INTELLECTUAL PROPERTY PROFESSORS IN SUPPORT OF PETITIONER

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Amici Curiae Intellectual Property Law Professors ("Amici") respectfully submit this brief in support of the Petitioner.[1]

INTEREST OF AMICI CURIAE

Amici, listed in Appendix A, are professors of law who research, write, and teach in the area of intellectual property. Amici's institutional affiliations are provided for identification purposes only, and imply no institutional endorsement of the views expressed herein. Amici have no personal stake in the outcome of this case. Counsel for all parties have consented to the filing of this brief.

SUMMARY OF ARGUMENT

In its 1976 revision of the Copyright Act, Congress decided to separate applied art from industrial design, admitting the former to copyright and excluding the latter. It drew this distinction precisely because it intended to differentiate copyright from design and utility patent. Congress recognized as applied art only those aesthetic features of a useful article that could

[1] Pursuant to Rule 37.6, Amici Curiae affirm that no counsel for any party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than Amici or their counsel made a monetary contribution to its preparation or submission. Counsel for both parties have consented to filing this brief.

be "separated" from that useful article rather than being integrated into the article.

The correct test of separability therefore considers conceptual separability to be nothing more than a coda to physical separability, and asks only whether the claimed design could be removed from the article and exist on its own as a pictorial, graphic or sculptural work that is not a useful article. This test minimizes the need for courts to make judgments about the aesthetic value of claimed features and the risk of anticompetitive strike suits. And it preserves the distinction Congress meant to draw between applied art and industrial design.

ARGUMENT

Congress made clear in the Copyright Act's legislative history its intent to distinguish *applied art* from *industrial design*, admitting the former to copyright protection, and excluding the latter. Focusing on Congress's distinction between applied art and industrial design is key to understanding how copyright's useful articles doctrine works, and, in particular, how a court may properly determine whether some aesthetic feature of a useful article is "separable" from the article's functional content and therefore protectable.

Courts should understand separability in terms of whether the claimed feature of a useful article (1) can be extracted from the article, even if doing so would destroy the article, and (2) once extracted, would stand

alone as an original pictorial, graphic, or sculptural work (PGS work) that is not a useful article. Features of useful articles that meet this test are properly classified as "applied art" – i.e., artistic content that has been "applied" to a useful article, a category of subject matter which, as this Court has previously held and Congress affirmed, does not lose its copyrightability by virtue of its application to a useful article. *See Mazer v. Stein*, 347 U.S. 201 (1954).

Courts in recent years have abstracted away from the distinction Congress intended and often have attempted to determine separability by inquiring whether the designer of a useful article was making aesthetic choices relatively unconstrained by function. *See Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 931 (7th Cir. 2004) ("Conceptual separability exists . . . when the artistic aspects of an article can be conceptualized as existing independently of their utilitarian function. This independence is necessarily informed by whether the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences.") (internal citations and quotation marks omitted); *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987). But that test has proven so difficult to apply that even when courts agree on the test, judges often disagree on the outcome of that test applied to particular cases. Indeed, that happened in this very case. *See Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468 (6th Cir. 2015).

The disagreement is not surprising; judges are not experts in design, and courts are neither well-positioned to understand the fine points of the design process for useful articles, nor to make judgments about the degree to which aesthetic choices are constrained by an article's function. Congress wisely did not invite such an inquiry.

I. Industrial Design v. Applied Art

In 1976, Congress replaced "works of art" as a category of copyrightable subject matter with "pictorial, graphic, and sculptural works." 17 U.S.C. § 102(5). The scope of this new category of copyrightable subject matter was then qualified with respect to the use of PGS works in "useful articles":

> [PGS works] shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article. 17 U.S.C. § 101.

According to the Copyright Act's legislative history, the statutory language dealing with useful articles was "drawn from Copyright Office Regulations promulgated in the 1940's," as well as language added to those regulations in the 1950's to implement this

Court's decision in *Mazer*, 347 U.S. 201. H.R. Rep. No. 94-1476, at 54 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659. According to those implementing regulations:

> If the sole intrinsic function of an article is its utility, the fact that it is unique and attractively shaped will not qualify it as a [copyrightable] work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for [copyright].

37 C.F.R. § 202.10(c) (1959). The new statutory language of the 1976 Act was intended "to draw as clear a line as possible between copyrightable works of applied art and uncopyrightable works of industrial design." H.R. Rep. No. 94-1476, at 55. As the House Report explained:

> The Committee has added language to the definition of 'pictorial, graphic, and sculptural works' in an effort to make clearer the distinction between works of applied art protectable under the bill and industrial designs not subject to copyright protection. . . .

Id. at 62-63. Thus, it is beyond peradventure Congress did not want to transform copyright law into a general industrial design protection system.[2]

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[2] Indeed, while separate protection for industrial design has been repeatedly proposed, Congress always declined to add it to

The statute draws the line between applied art and industrial design first by requiring a determination of whether the object at issue is a "useful article." The statutory definition of "useful articles" is broad, encompassing all articles "having *an* intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101 (emphasis added).[3] For articles with any such intrinsic utilitarian function, the statute requires a second inquiry into the separability of any aesthetic features of the article.

II. The Separability Test

Elaborating on its understanding of separability, the House Report said that "[a] two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a

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the Copyright Act. *See Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431, 1446-47 (3d Cir. 1994) (recounting the history of congressional rejection); *In re Nalbandian*, 661 F.2d 1214, 1219 (C.C.P.A. 1981) (Rich, J., concurring) (explaining that design protection was initially included in the 1976 Act, but "was jettisoned to facilitate passage of the main bill").

[3] Congress expanded the definition of "useful article" with this language, broadening the former language, "sole utilitarian function." *See* Pamela Samuelson, *CONTU Revisited: The Case Against Copyright Protection for Computer Programs in Machine-Readable Form*, 1984 DUKE L.J. 663, 730-32 (1984).

product without losing its ability to exist independently as a work of art." H.R. Rep. No. 94-1476, at 55.

By contrast, "although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention [was] not to offer it copyright protection under the bill." *Id.* Thus, "[u]nless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted. . . ." *Id.*

As the House Report makes clear, aesthetic features are separable under this approach if they can have a separate existence as a copyrightable work apart from the useful article to which they have been applied. The "over-all configuration," *id.*, of a useful article is simply not protectable under any circumstances; Congress protected sculptural works applied to lamps, not lamps. It is irrelevant to Congress's distinction whether the features could have been designed differently or whether they were designed "independently" of functional considerations. *Cf. Brandir*, 834 F.2d at 1145. "[I]ndependence from 'the utilitarian aspects of the article' does not depend upon the nature of the design – that is, even if the appearance of an article is *determined* by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable." H.R. Rep. No. 94-1476, at 55 (emphasis added).

The examples of features Congress considered separable under this standard – "a carving on the back of a chair" and "a floral relief design on silver flatware" – all follow a common theme. *Id.* Congress clearly meant to protect features of useful articles that could exist as a separate copyrightable work in some other medium. The further examples included by the Copyright Office in its Compendium of U.S. Copyright Practices – "[a]n engraving on a vase," "[a]rtwork printed on a t-shirt," "[a] colorful pattern decorating the surface of a shopping bag," "[a] drawing on the surface of wallpaper," and "[a] floral relief decorating the handle of a spoon" – follow this theme as well. COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES III § 924.2(B) (2014). Conversely, Congress meant to exclude from copyright protection features that are integrated into a work of industrial design and make sense only as part of that useful article.

This understanding allows courts to apprehend and follow the statutory command that copyrightable features of useful articles are limited to "features that can be *identified* separately from, and are *capable of* existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101 (emphasis added). Aesthetic features of a useful article are "capable" of existing separately if they can be removed or extracted from the useful article and the removed design would constitute a PGS work, but not the design of a useful article. This understanding also makes clear that courts have substantially overcomplicated so-called "conceptual" separability. Conceptual separability is not terra incognita

or some invitation for courts to develop their own theory of what is art versus function. It is, rather, a modest extension of the concept of physical separability, the other category that Congress specified in the Copyright Act's legislative history.

Physical separability is found, for example, in an epaulet that is sewn onto the shoulder of a jacket and that may be readily removed without destroying the jacket. "Conceptual" separability is closely related: it is no more than separability that could not, in actual fact, be carried out physically without destroying the underlying useful article – an example would be a graphic design on an epaulet printed onto the shoulder of the same jacket. Conceptual separability is a kind of coda to physical separability.

Stated another way: if one could extract the claimed features and use them on their own in another context without replicating the useful article of which they are part, and the result would be a copyrightable PGS work standing alone, then there is separable matter. On the other hand, if extracting the claimed features would necessarily bring along the underlying useful article, the design is inseparable from the useful article. For example, an artistic design printed onto a poster, and then veneered onto the back of a chair, might be separable in the ordinary physical sense. The same artistic design carved into the back of the chair might not actually be removable without destroying the chair. That design is nonetheless separable "conceptually," for the same reason the design printed on the poster is: the work would be the same work as a

design on paper – a copyrightable graphic work. It therefore is capable of an independent existence apart from the underlying useful article. Likewise, the plaster-of-Paris sculpture encasing the electrical cords and wiring in the lamp in *Mazer v. Stein* could not be physically separated from the cords and wiring without destroying the lamp (because of the materials from which it was made), but the sculpture standing on its own was not a lamp: it was a conceptually separable sculptural work. *See Mazer*, 347 U.S. 201.[4]

The test we propose faithfully implements Congress's intent. The House Report states that "a two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like," and that "[t]he same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art." H.R. Rep. No. 94-1476, at 62-63. This statement is consistent in its entirety with the test Amici propose.

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[4] One possible way to characterize the test Amici offer is that courts should ignore the physical integrity of the underlying useful article in assessing separability. As indicated by the list of representative examples Congress offered, it is the impossibility of removing some applied art without destroying the underlying object that led Congress to add "conceptual" separability, to make clear that the useful article need not be preserved post-separation for "separability" to exist.

III. Separability Offers a Clear Way to Understand Most Useful Article Cases

Many older cases express a clear understanding of the close connection between physical and conceptual separability. *Compare Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978) (denying copyright protection to design of street lights), *with Royalty Designs v. Thrifticheck Service Corp.*, 204 F. Supp. 702 (S.D.N.Y. 1962) (finding copyrightable a coin bank shaped like a dog, where shape was original), *and Ted Arnold Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) (finding copyrightable the design of a pencil sharpener in the shape of an old-fashioned telephone that was not a copy of any real telephone).[5] As the courts have made separability more complicated and contestable, plaintiffs have brought more extreme cases, reflecting the litigation-generating effect of standards that are both broad and unpredictable. *Cf. Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213-14 (2000) (noting that anticompetitive suits are facilitated by unclear tests and that "[c]ompetition is deterred . . . not merely by successful suit but by the plausible threat of successful suit," justifying rules that are as bright-line as possible).

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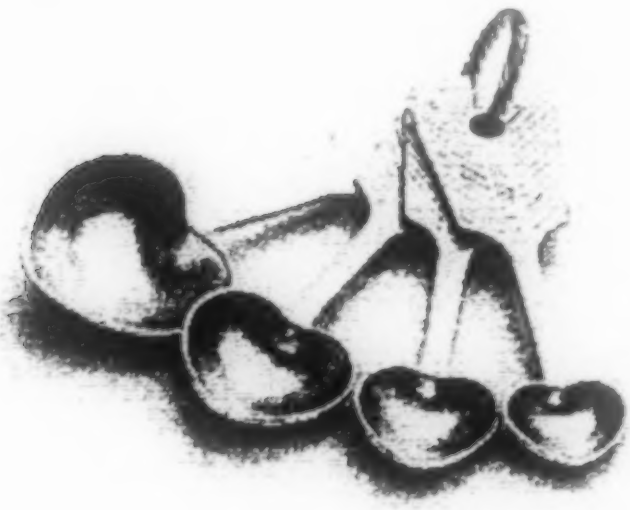
[5] As noted below, copyrightable elements are limited to the creativity added by the creator, and also subject to the originality and merger doctrines. *See L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 489 (2d Cir. 1976) (holding that a copy of a public domain bank was not independently copyrightable because changes were made for functional, not creative, reasons).

By focusing on separability, Amici's proposed test offers a simpler path to correct results. In *Universal Furniture Intern., Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417 (4th Cir. 2010), the court correctly found that the designs engraved into plaintiff's furniture were separable, although its reasoning conflated the question of aesthetics with that of protectability. *See id.* at 423 (finding separability because the purpose of carving the designs "was entirely aesthetic," even though the artist was also "influenced by function" in designing the elements; nonetheless, the court thought it faced a "metaphysical quandary" because "[t]he elements serve no purpose divorced from the furniture – they become designs in space"). Under our proposed analysis, the separability of engraved ornamental designs is clear.

The result in *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404 (11th Cir. 2015) (finding designs on laminated floor tiles physically and conceptually separable), is also consistent with our test, although the Eleventh Circuit made the case more difficult by asking whether the design was separately marketable in order to determine whether it was separable. There is probably no real market for pictures of wood grain. But just as aesthetic merit is not an appropriate inquiry for courts, neither is whether a creative work has a market waiting for it. The appropriate question is whether the design could stand alone as a work, not whether the work would have a market.

Similarly, *Bonazoli v. R.S.V.P. Intern., Inc.*, 353 F. Supp. 2d 218 (D.R.I. 2005), the court correctly found

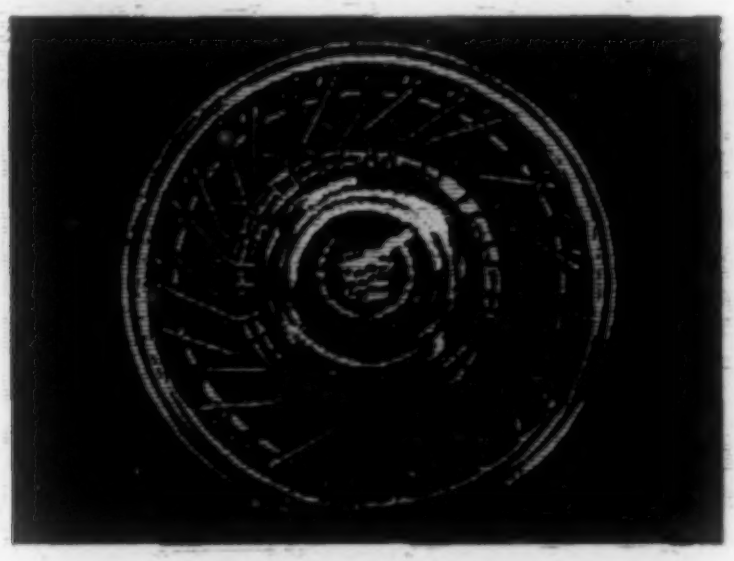
that the design features of measuring spoons shaped like heart-tipped arrows were not separable, because replicating the design would necessarily produce measuring spoons, which are useful articles.



See also Jovani Fashion, Ltd. v. Cinderella Divine, Inc., 808 F. Supp. 2d 542 (S.D.N.Y. 2011) (prom dress design lacked separability), *aff'd sub nom. Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 Fed. App'x 42 (2d Cir. 2012); *Magnussen Furniture, Inc. v. Collezione Europa USA, Inc.*, 116 F.3d 472 (4th Cir. 1997) (table design features were not separable).

In *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038 (9th Cir. 2014), the Ninth Circuit properly held that the overall shape of a useful article is not copyrightable no matter how aesthetically pleasing that shape may be. *See id.* at 1042 (holding that although

Inhale's water container, like a piece of modern sculpture, has a distinctive shape, "[t]he shape of the alleged 'artistic features' and of the useful article are one and the same."). *See also Esquire*, 591 F.2d at 804 (noting that the legislative history indicates "unequivocally that the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright"). Our proposed test implements this result. Any replica of the overall shape would replicate the useful article (even if it would not function because, for example, it was made out of different material). *See also Norris Industries, Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir. 1983) (no protection for wire-spoked wheel cover).



Nor can inseparability be avoided by defining the claimed design to be only a portion of a useful article. For example, in *Eliya, Inc. v. Kohl's Dept. Stores*, No. 06 Civ. 195(GEL), 2006 WL 2645196 (S.D.N.Y. 2006), the plaintiff claimed protection for the stitching and sole

patterns on a shoe; the court properly found lack of separability. Even in the abstract and without other material present, the configuration of the stitching and patterns on the sole still defined a shoe. If abstracted away from the shape of a shoe, moreover, the only thing remaining would be unoriginal circles and stitches. By attending to the fact that three-dimensional designs regularly depend on three-dimensional relationships between elements, copyright's originality requirement can thus police against attempts to game the separability standard by claiming only portions of an article.

IV. Separability Channels Industrial Design to Design Patent

Excluding inseparable features does not leave design without protection. Instead, the union of form and function can readily be protected through the law of design patent, as Congress intended. *See* Mark P. McKenna & Katherine J. Strandburg, *Progress & Competition in Design*, 17 STAN. TECH. L. REV. 1, 48-51 (2013) (focusing on the integration of form and function to define design patent subject matter).

This distinction between the protection offered by design patent and the protection offered by copyright corresponds to the simple conceptual separability test outlined above. Moreover, it allows the Court to more easily distinguish between works of applied art and works of industrial design without resorting, as the lower courts have, to some detailed theory of how to separate art from function. If the claimed subject matter is integrated into the design of the useful

article or the part of the useful article which the subject matter comprises, then the claimed subject matter is a work of industrial design, and protectable, if at all, by design patent. This is true even though industrial designs, like copyrightable works, have aesthetic qualities and might be perceived as "art" by patrons thereof.[6] The idea of separability, in other words, is the removal of something from the useful article – which necessarily implies that the separable features must be less than the whole. The mere fact that the useful article can be appreciated aesthetically says nothing about whether the design is separable.

Neither are features separable simply because they are aesthetic; if that were the test, then the only useful articles that would be unprotected by copyright would be those without any attractive features. But (nearly) all industrial design is a mix of aesthetic and functional. The Copyright Act reaches industrial design only insofar as the pictorial, graphic or sculptural content of a particular useful article may exist without the underlying article. To the extent this test is met, then that PGS feature is copyrightable as a work of applied art.

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[6] The United States recently joined the Hague Agreement. *See* Patent Law Treaties Implementation Act, Pub. L. No. 112-211, 126 Stat. 1527 (2012). In implementing it, the U.S. decided to channel foreign industrial design applications to the design patent system. *See* 35 U.S.C. § 385 ("An international design application designating the United States shall have the effect, for all purposes, from its filing date determined in accordance with section 384, of an application for patent filed in the Patent and Trademark Office pursuant to chapter 16."). This decision bolsters the argument that copyright is the wrong home for industrial design.

The application of this analysis to the design of cheerleader uniforms or other clothing designs is simple and clear: the aesthetic elements of a cheerleader uniform exist only as part of a cheerleader uniform. There is nothing to extract; the claimant claims the design of a useful article. By contrast, a fabric print would be the same artwork if it were on a notebook cover, wallpaper, or other surface.

The claimant here could, using an analogy to fabric prints, claim only the chevrons and not the coordination and arrangement thereof, which constitute the cut of the garment. But that is not what the claimant asserts, likely because the chevrons themselves are standard uniform elements that lack the minimal spark necessary for copyrightability. *Cf. Design Ideas, Ltd. v. Yankee Candle Co., Inc.*, 889 F. Supp. 2d 1119 (C.D. Ill. 2012) (finding that candle holders in the generalized shape of sailboats were probably not separable, but definitely not creative enough for copyright protection).

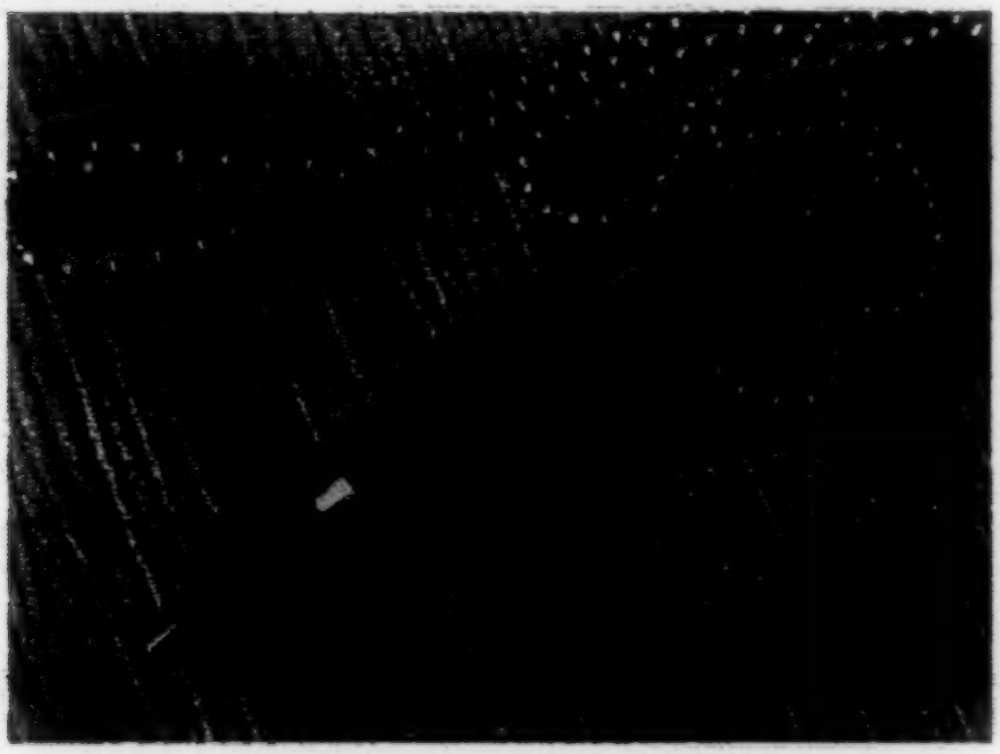
See also Eliya, 2006 WL 2645196 (similar result for design on outside of shoe).

This analysis highlights an important point: separability is part of a larger scheme, in which multiple doctrines have roles to play. The originality, idea/expression, and merger doctrines limit the copyrightability of all creative works. Section 113(b) of the Copyright Act is of particular import here. Section 113(b) provides that a copyright in a work depicting a useful article does not extend to the manufacture, distribution, or display of that useful article. 17 U.S.C. § 113(b); *see, e.g.*, *Forest River, Inc. v. Heartland Recreational Vehicles, LLC*, 753 F. Supp. 2d 753, 759-60 (N.D. Ind. 2010) (applying § 113(b)); William F. Patry, Patry on Copyright § 11:13 (2016) ("[C]opyright in a drawing of a boiler, cabinet, or automobile would not prohibit unauthorized manufacture from drawings of those objects.") (footnote omitted).

Thus, drawings or photographs of the uniform designs at issue, like drawings or photographs of any other real-world objects, are copyrightable to the extent that they evince creativity, but they could not be asserted against the making of the underlying useful articles. *See Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884); *see also* H.R. Rep. No. 94-1476, at 105 (explaining that the purpose of § 113(b) was to preserve the principle that "copyright in a pictorial, graphic, or sculptural work, portraying a useful article as such, does not extend to the manufacture of the useful article itself").

Section 113(b) and separability are two sides of the same coin, working together to solve the problems caused by excluding industrial design from copyright.

Patry, *supra* § 11:12 ("Both section 113(b) and the separability test for protection are designed to address this conundrum [when the plaintiff's work depicts a useful article]."). With the combination of separability and § 113(b), one cannot claim copyright in a useful article by putting it on a necklace and wearing it as jewelry, no matter how aesthetic the effect:



Armageddon Art, *Real .223 Bullet Necklace with 24 Inch Chain*, Etsy, (last modified July 2, 2016).[7]

Likewise, an artist cannot draw a design or carve a sculpture for a new bullet, no matter how beautiful, and get a claim over the resulting useful article. *Cf. Baker v. Selden*, 101 U.S. 99, 103 (1879) ("The copyright

[7] https://www.etsy.com/listing/104890409/real-223-bullet-necklace-with-24-inch.

of a book on perspective, no matter how many drawings and illustrations it may contain, gives no exclusive right to the modes of drawing described, though they may never have been known or used before."); J.H. Reichman, *Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976*, 1983 DUKE L.J. 1143, 1207-08 (1983) (explaining the derivation of § 113(b) from *Baker*). The artist's copyright is limited to the original elements of the PGS work depicting the useful article, preserving her copyright interest in the art market without interfering with the market for useful articles. *Cf. Brandir*, 834 F.2d at 1147 (finding design of a bike rack inseparable from its status as a bike rack, while sculpture that looked like a bike rack, or a bike, could be copyrightable if original).

For this reason, hypotheticals involving useful articles rendered in different sizes or materials – such as a toy-sized uniform or a chair made out of tissue paper – are inappropriate for determining whether the aesthetic features of the design that the claimant actually made are separable.[8] If we allow imaginary manipulations of the physicality of the article, no useful article would ever be excluded from copyright, because at some scale or in some material the utility of any article, or of any feature of an article, can be removed. The fact that sculptures could be, and in fact have been,

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[8] The question of whether toys are themselves useful articles is a difficult one, but one this Court need not decide, since no toys are involved here.

designed to look like sailboats does not mean that sailboats are not useful articles.

In sum, Amici's proposed test offers a relatively simple way to distinguish applied art from industrial design, and thereby to distinguish separable from inseparable PGS features of useful articles. That said, no test will apply with perfect clarity to all cases. Because of the inevitable fuzziness in practice, the related risk of oppressive and anticompetitive threats of suit, and the availability of design patent protection for useful articles, Amici suggest that the Court apply its well-grounded reasoning in *Wal-Mart*, 529 U.S. at 215: in cases of doubt, a court should find that the claimed matter is industrial design and therefore not separable.

V. Other Approaches to Separability and Their Problems

The chaos in the courts of appeals and the extensive body of commentary on separability indicate that current approaches have largely failed to produce rules that courts can apply consistently; only our approach offers a simple way out, grounded in the statute. In contrast to this straightforward account of conceptual separability – one that is consistent with the text of the Copyright Act and Congress's intent as expressed in the Act's legislative history – the various incompatible tests currently employed by courts try to do something that is conceptually intractable, which is to separate protectable art from unprotectable functionality. Thus,

many courts have articulated tests of conceptual separability that focus on whether particular features were determined by aesthetic rather than functional considerations. *See Pivot Point*, 372 F.3d at 931 (collecting cases).

That approach faces two insurmountable problems. First, it puts the law at odds with the subject matter the law is regulating. Indeed, it is often observed that modern designers think of what they do in terms of the *integration* of form and function – that is, as the opposite of separability. Frank Lloyd Wright, *The Future of Architecture* 296 (1953) ("Form and function are one."); *see also* Viva R. Moffat, *The Copyright/Patent Boundary*, 48 U. RICH. L. REV. 611, 660 (2014) ("The very best industrial design will seamlessly integrate form and function."); Brett S. Sylvester, *The Future of Design Protection in the United States*, 20 J. MARSHALL L. REV. 261, 271 (1986) ("[T]he majority of modern industrial designs are heavily influenced by the Bauhaus approach to design which stresses the unification of form and function.").

Second, it runs squarely against Congress's intent by putting courts in the role of art theorists separating the aesthetic from the functional. The relatively simpler separability analysis outlined above allows courts to distinguish separable (and therefore copyrightable) applied art from inseparable elements of industrial design, however aesthetically pleasing. Reichman, 1983 DUKE L.J. at 1261-62 (explaining that the definition of PGS works was intended to channel cases away from copyright and into separate industrial design

legislation, which was then removed from the final bill). Congress defined PGS works as it did because it wanted to differentiate the domain of copyright from that of design patent, the legal regime that protects the ornamental, aesthetic features of industrial design. *See* H.R. Rep. No. 94-1476, at 54.

Courts' attempts to differentiate aesthetics and function has led them astray in a number of cases. The features of the belt buckle in *Kieselstein-Cord* could not be replicated without replicating a belt buckle. The court was therefore wrong to find conceptual separability just because the belt buckle could be used (as a whole) as jewelry. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) ("We see in appellant's belt buckles conceptually separable sculptural elements, as apparently have the buckles' wearers who have used them as ornamentation for parts of the body other than the waist.").

Kieselstein-Cord got the distinction wrong because the court asked whether the *article* could be used in some other, nonutilitarian context rather than asking whether any *features* of the article could have a separate existence. *Kieselstein-Cord*, 632 F.2d at 993. In other words, *Kieselstein-Cord* mistakenly conflated separability with the question of whether the buckle would be useful in any context in which it was put (which, of course, no useful article is). Putting a urinal in a museum was art, at least when Duchamp did it; that does not mean the urinal was copyrightable. Likewise, exhibiting a buckle in an art museum, or wearing it around one's neck, does not make the design of the

buckle separable from the buckle itself.[9] There may be thirteen (or more) ways of looking at a belt buckle, but the buckle itself remains a buckle.

In *Carol Barnhart*, the court considered whether the aesthetic and artistic features were separable from the forms' use as utilitarian articles (torsos for displaying clothing). *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985). Judge Newman, in dissent, would have asked whether the article "stimulate[s] in the mind" of the "ordinary, reasonable observer" "a concept that is separate from the concept evoked by its utilitarian function." *Carol Barnhart*, 773 F.2d at 422 (Newman, J., dissenting). This is the overcomplicated conceptual fallacy discussed above: the question is not whether one can look at a urinal, or a Porsche, and see art. The legislative history of the 1976 Act explains that the definition of "'pictorial, graphic, and sculptural works' carries with it no implied criterion of artistic taste, aesthetic value, or intrinsic quality." H.R. Rep. No. 94-1476, at 55. The question is whether features of the Porsche could have a separate existence as a work. And clearly they cannot. Neither could the torso forms in *Carol Barnhart*.[10]

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[9] Design patent, however, would remain available for any similar novel design that was timely registered.

[10] It is also important to remember that significant work takes place at the stage of identifying what is a "useful article" as well. Ordinarily, sculptures are not useful articles, though people can hang clothes (or lampshades) on them. Again, the Court is not asked here to articulate a test for determining in every case what a "useful article" is. If the Court asks separability to do too much of the definitional work for which originality, the scope of "useful

Another Second Circuit panel in *Brandir* as well as a Seventh Circuit panel in *Pivot Point* focused on the designer's intention in creating the work, holding that copyrightability "should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations." *Brandir*, 834 F.2d at 1145 (quoting Robert Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741-45 (1983)); *see also Pivot Point*, 372 F.3d at 926-27 (adopting *Brandir*/Denicola test). This approach is directly contrary to congressional guidance in the legislative history, which made clear that the fact that features were developed for aesthetic reasons independent of function did not make them separable. H.R. Rep. No. 94-1476, at 55 (emphasizing Congress's intention to exclude industrial design that was "aesthetically satisfying and valuable" from copyright).

Finally, the Fifth Circuit in *Galiano* asked whether claimed copyrightable aspects of the work are themselves "marketable to some significant segment of the community." *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005). Again, the court's test wrongly collapses separability into artistic quality. Highly marketable, beautiful designs are protectable by design patent; artistic works for which there is no market are protectable by copyright.

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article," and other doctrines are better suited, it risks continuing the incoherence and struggle that produced the present mishmash of cases.

CONCLUSION

Congress decided to separate industrial design from applied art, leaving industrial design protectable, if at all, only through utility patent or design patent. To protect this distinction and limit the coverage of copyright to applied art, the Court should adopt the simplest possible test for separability, one that minimizes the need for courts to make aesthetic judgments and the risk of anticompetitive strike suits. A test that considers conceptual separability to be a coda to physical separability, and therefore asks only whether the claimed design could be removed from the article and have an existence as a PGS work, or whether instead the claimed design is the article (or part thereof), is the best approach.

Respectfully submitted,

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APPENDIX A

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